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10/660,535

09/12/2003

Tsutomu Ohishi

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06/02/2008

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EXAMINER

ORANGE, MARIAMA N

ART UNIT

PAPER NUMBER

2625

NOTIFICATION DATE

DELIVERY MODE

06/02/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/660,535 | <b>Applicant(s)</b><br>OHISHI ET AL. |  |
|                              | <b>Examiner</b><br>Mariama Orange    | <b>Art Unit</b><br>2625              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to applicant's amendment and remarks received on 29 February 2008. Claims 1-6, 8-15, and 17-20 are currently pending.

### ***Specification***

2. The previous objection to the title of the disclosure is withdrawn in light of applicant's amendment.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8-15, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (US Patent Application Publication 2002/0033964), hereinafter referenced as Suzuki.

Regarding claim 1, Suzuki discloses a print system (11) with a scanner (12) and plurality of image output units at paragraph [0094], and exhibited in figure 1, which reads on claimed “image forming apparatus including a scanner engine and an operation panel.” Suzuki further discloses a display panel (12B) provided with the scanner (12), which functions as a user interface for displaying a screen having a plurality of icons and is for inputting data by touching one of the icons displayed at paragraph [0095], and exhibited in figure 2, which reads on claimed “display part

configured to display a selection screen for selecting a transfer destination of scanned data from among a plurality of transfer destinations on the operation panel.” Suzuki further discloses a controller (12C) for controlling the scanner as a whole at paragraph [0095], and exhibited in figure 2, which reads on claimed “scanning process part configured to cause the scanner engine to scan a document to produce scanned data.” Suzuki further discloses an input/output port (12E) for inputting/outputting data at paragraph [0095], and exhibited in figure 2, which reads on claimed “transfer part configured to transfer the scanned data to one or more selected transfer destinations.” Suzuki further discloses printers (16) at paragraph [0094], and exhibited in figure 1, which reads on claimed “print process part configured to receive the scanned data from a storing area of the selected transfer destination and print the scanned data.”

Regarding claim 2, Suzuki discloses everything claimed as applied above (see claim 1); in addition, Suzuki discloses a document data storage connected to a network at paragraph [0041]; a user storing document data with the server (14, exhibited in figure 1) acting as a WWW server at paragraph [0168]; and the image being output as an electronic mail at paragraph [0232], which reads on claimed “one or more selected transfer destinations” including “one or more of a storing area on a WEB server on a network, a mail destination, and a shared storing area on a network.”

Regarding claim 3, Suzuki discloses everything claimed as applied above (see claim 2); in addition, Suzuki discloses a displayed control screen and administration control screen for inputting user and document data information at paragraphs [0044] and [0046], wherein a user can perform an outputting routine via transmission of a

registration ID at paragraph [0052], which reads on claimed “image forming apparatus,” wherein, “if authentication information is required for accessing the storing area or the shared storing area, the display part displays a screen for inputting the authentication information when the storing area or the shared storing area is selected.”

Regarding claim 4, Suzuki discloses everything claimed as applied above (see claim 1); in addition, Suzuki discloses the display panel (12B, exhibited in figure 2) having a plurality of icons corresponding to output formats at paragraph [0095] and memory (12D, exhibited in figure 2) storing programs for processing routines at paragraph [0096], including a step 178 (exhibited in figure 7B) of output format inputted from the control screen and image data read from the scanner unit (12A, exhibited in figure 2) being transmitted to the server (14, exhibited in figure 1) at paragraph [0125], which reads on claimed “image forming apparatus” wherein “the display part displays a screen for selecting a data type of scanned data to be transferred among from a plurality of data types, and the transfer part converts the scanned data into data of the data type, and transfers the data of the data type.”

Regarding claim 5, Suzuki discloses everything claimed as applied above (see claim 4); in addition, Suzuki discloses a step 176 (exhibited in figure 7B) where a series of image data are read as common image data and are stored as electronic data at paragraph [0125], which reads on claimed “image forming apparatus,” wherein “the plurality of data types include a type of recognized data that is obtained by performing character recognition process on the scanned data.”

Regarding claim 6, Suzuki discloses everything claimed as applied above (see claim 5); in addition, Suzuki discloses the output format inputted from the control screen and the image data read from the scanner unit (12A) being transmitted to the server (14) at paragraph [0125], and exhibited in figures 1 and 2, which reads on claimed “image forming apparatus,” wherein, “when the recognized data is selected as a data type, the transfer part sends the recognized data and the scanned data to a transfer destination.”

Regarding claim 8, Suzuki discloses everything claimed as applied above (see claim 1); in addition, Suzuki discloses a print control screen display instructed from the display panel (12B) of the scanner (12), exhibited in figure 1 and figure 2, at [0113], where printing is instructed at paragraph [0123], and exhibited in figure 7A, which reads on claimed “image forming apparatus,” wherein “the print process part displays, on the operation panel, a data selection screen for displaying a list of scanned data stored in the storing area, and prints scanned data selected from the list.”

Regarding claim 9, Suzuki discloses everything claimed as applied above (see claim 1); in addition, Suzuki discloses processing routines executed by the respective controllers of the scanner, the server and the printer, where the processing routines are divided into individual routines for attribute information registering, control screen displaying, print instructing and printing at paragraph [0106], and exhibited in figure 5 to figure 7B, which reads on claimed “image forming apparatus further comprising hardware resources used for image forming processes, and control services that perform processes of the system side including control of the hardware resources

according to a request from an application, wherein the image forming apparatus is configured so as to be able to install a plurality of applications separately from the control services, and the image forming apparatus includes the scanning process part, the display part and the transfer part as an application.”

Regarding claims 10-15 and 17-18, Suzuki discloses everything claimed as applied above (see claims 1-6 and 8-9); in addition, claims 10-15 and 17-18 are inherent to claims 1-6 and 8-9 because they describe the process for implementing the structure of claims 1-6 and 8-9. Therefore, claims 10-15 and 17-18 are rejected.

Regarding claim 19, Suzuki discloses a print system (11) with a scanner (12) and plurality of image output units at paragraph [0094], and exhibited in figure 1, which reads on claimed “image forming apparatus including a scanner engine and an operation panel.” Suzuki further discloses a display panel (12B) provided with the scanner (12), which functions as a user interface for displaying a screen having a plurality of icons and is for inputting data by touching one of the icons displayed at paragraph [0095], and exhibited in figure 2, which is equivalent to claimed “means for displaying a selection screen for selecting a transfer destination of scanned data from among a plurality of transfer destinations on the operation panel.” Suzuki further discloses a controller (12C) for controlling the scanner as a whole at paragraph [0095], and exhibited in figure 2, which is equivalent to claimed “means for causing the scanner engine to scan a document to produce scanned data.” Suzuki further discloses an input/output port (12E) for inputting/outputting data at paragraph [0095], and exhibited in figure 2, which is equivalent to claimed “means for transferring the scanned data to one

or more selected transfer destinations." Suzuki further discloses printers (16) at paragraph [0094], and exhibited in figure 1, which is equivalent to claimed "means for receiving the scanned data from a storing area of the selected transfer destination selected and for printing the scanned data."

Regarding claim 20, Suzuki discloses at paragraph [0040], with reference to the invention exhibited in figure 1, a computer-readable recording medium recorded with an electronic filing program for causing a computer for administering the electronic filing to execute: generating filing screen data and outputting the generated filing screen data to a first client, for displaying a filing screen at the first client, to enable filing of document information relating to a document; generating administration screen data and outputting the generated administration screen data to a second client, for displaying an administration screen at the second client, to enable administration of the document information; receiving through the network the document information filed at the filing screen displayed at the first client and displaying the received document information at the administration screen displayed at the second client; and on the basis of input information which is inputted to the administration screen, outputting the document to an output device connected to the network, which reads on claimed computer readable medium including computer executable instructions" for "displaying a selection screen for selecting a transfer destination of scanned data from among a plurality of transfer destinations on the operation panel; causing the scanner engine to scan a document to produce scanned data; transferring the scanned data to one or more selected transfer destinations; and receiving the scanned data from a storing area of the transfer



destination and printing the scanned data on a print process part included in the image forming apparatus."

***Response to Arguments***

4. Applicant's arguments filed 29 February 2008 have been fully considered but they are not persuasive.

5. In response to applicant's argument, with regards to claim 1, that Suzuki describes, at paragraph [0095], how the user interface is used to select a printing format, not a destination for scanned data, a printing format can be interpreted to comprise a destination for scanned data. More specifically, Suzuki discloses at paragraph [0095], and exhibited in figure 2, a display panel (12B) provided with the scanner (12), which functions as a user interface for displaying a screen having a plurality of icons and is for inputting data of printing format (or output formats) of a printer by touching one of the icons displayed. Therefore, Suzuki satisfies all the elements of claim 1, including "a display part configured to display a selection screen for selecting a transfer destination of scanned data from among a plurality of transfer destinations on the operation panel."

6. In response to applicant's argument, with respect to claims 1 and 10 and all claims depending therefrom, that the printer 16 described by Suzuki is geographically displaced from a scanner and, thus, Suzuki fails to teach or suggest an image forming apparatus with all the limitations of claim 1, or a scanned data process method with all the limitations of claim 10, Suzuki discloses at paragraph [0094], and exhibited in figure 1, a print system (11) with a scanner (12) and plurality of image output units, including

printers (16), where the various components of the printing system are connected via network (10). Irrespective of any geographic distance between the components of the print system (11), the print system (11) still reads on the claimed image forming apparatus and, therefore, Suzuki satisfies the "print process part configured to receive the scanned data from a storing area of the selected transfer destination and print the scanned data" limitation recited in claim 1 and the "receiving the scanned data from a storing area of the transfer destination and printing the scanned data on a print process part included in the image forming apparatus" limitation recited in claim 10. Therefore, Suzuki satisfies all the elements of claims 1 and 10, and all claims depending therefrom, specifically claims 2-6, 8-9, 11-15, and 17-18, as applied above.

7. In response to applicant's arguments that claim 19 is amended to recite the same limitations as claim 1, and claim 20 includes all the limitations of claim 10, Suzuki accordingly teaches all the limitations of claims 19 and 20 as discussed and applied above.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2625

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mariama Orange whose telephone number is (571) 270-3577. The examiner can normally be reached on 9AM-5PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Application/Control Number: 10/660,535

Page 11

Art Unit: 2625

/Twyler L. Haskins/

Supervisory Patent Examiner, Art Unit 2625